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EXAMINER

YUAN, ALMARI ROMERO

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 02/12/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/339,733

Applicant(s)

COTTRILLE ET AL.

Examiner

Almari Yuan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: Request for RCE filed on 11/24/03 and After Final Amendment filed on 9/22/03.
2. The rejection of claims 1-28 under 35 U.S.C. 103(a) as being unpatentable over van Hoff, deVries, and Van Der Meer has been withdrawn as necessitated by amendment and based on Applicant's remarks in the After Final Amendment filed on 9/22/03.
3. Claims 1-28 are pending in the case. Claims 1, 10, 22, 23, 24, and 25 are independent claims.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/24/03 has been entered.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eintracht et al. (USPN 6,687,878 B1 – filed on 03/1999) in view of deVries et al. (USPN 6,332,144 B1 – filed on 12/1998).**

Regarding independent claim 1, Eintracht discloses:

A computing system for scalably managing annotations (Eintracht see Abstract teaches a collaborative document annotation system), the computing system comprising:

a tier III server for storing annotations (Eintracht on col. 10, lines 40-63, see Figure 3 item 60 teaches Notes Database 30 tracks all annotations and other activities; see Abstract notes associated with a document are stored in a notes database);

a tier II server for storing an index of the annotations stored on the tier III server, but not the annotations, that is separate and distinct from the tier III server (Eintracht on col. 8, lines 61-63 teaches Notes Server assigns a unique Note Serial Number upon the creation of each note; wherein the number serves to identify each note in the system; col. 10, lines 27-39, see Figure 3 teaches a Notes Server 58 functions to receive modified URLs from the Note Agent; the Notes Server receives request from the Web Server to retrieve annotations from the Notes Database 30); and

a tier I server for determining if a content source has an index of the annotations stored on the tier II server, that is separate and distinct from the tier II and tier III servers (Eintracht on col. 9, lines 49-52 and col. 10, lines 27-39, see Abstract and Figure 3 teaches Web server 54 captures requests from client for creating, storing, editing, and retrieving annotations related to specific documents stored on the Notes Database).

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However, Eintracht does not explicitly disclose that the Notes Database for storing annotations is a “tier III server”.

deVries on col. 7, lines 26-40 see Figure 1A items 30 and 32 teaches an index database server 32 for storing annotations.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified deVries into Eintracht to provide a way to store annotations in an index database server, as taught by deVries, incorporated into the Notes Database of Eintracht in order provide an efficient and cost-effective distributed annotating media system.

Regarding dependent claim 2, Eintracht discloses:

wherein the tier II server further stores a plurality of generic properties for the annotations (Eintracht on col. 10, lines 27-39, see Figure 3 teaches a Notes Server 58 functions to receive modified URLs from the Note Agent; on col. 10, lines 40-41 teaches Note Server 58 functions to keep track of all annotation activity in the Notes Database 60).

Regarding dependent claim 3, Eintracht discloses:

wherein the tier III server further stores one or more type specific properties for the annotations (Eintracht on col. 10, lines 40-63 teaches Notes Database 60 records Note Document ID, Note Contents, Note Anchor coordinates, Note Time Stamp, and Note Owner ID).

Regarding dependent claims 4-6, Eintracht discloses:

wherein the tier I, II, III server comprises a plurality of servers (Eintracht on col. 8, lines 44-46 teaches the system can be implemented to operate over LAN, WAN or the Internet comprising a plurality of servers systems).

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Regarding dependent claim 7, Eintracht discloses:

wherein the tier III server further stores client software to allow a user to view a type of annotation (Eintracht on col. 10, lines 40-63 teaches database is a useful tool for tracking all annotations and other activities).

Regarding dependent claim 8, Eintracht discloses:

wherein the content source is identified by a document identifier (Eintracht on col. 4, lines 16-17 teaches URL associated with a document to be viewed).

Regarding dependent claims 9 and 28, Eintracht discloses:

wherein the document identifier is selected from the group consisting of: a directory path, a uniform resource locator, and a file name (Eintracht on col. 8, lines 50-51 teaches URL (uniform resource locator)).

Regarding independent claim 10, Eintracht discloses:

A scalable computerized method of posting an annotation (Eintracht see Abstract teaches a system for creating, storing, editing and retrieving annotations related to specific documents), the method comprising:

sending an annotation post from a client to a tier III server (Eintracht on col. 16, lines 12-29 teaches posting note data to the Note Sever to create a new record in the Note Database for the new note);

storing a portion of the annotation post on the tier III server (Eintracht on col. 10, lines 40-63, see Figure 3 item 60 teaches Notes Database 30 tracks all annotations and other activities; see Abstract notes associated with a document are stored in a notes database);

sending a second portion of the annotation post from the tier III server to a tier II

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server that is separate and distinct from the tier III server (Eintracht on col. 7, lines 45-47 and col. 10, lines 40-63, see Abstract teaches the Note Server and Note Database are in communication with each other; wherein annotations are posted to the notes server by a notes client, the state of the annotation is synchronized);

storing the second portion of the annotation post on the tier II server (Eintracht on col. 8, lines 61-63 teaches Notes Server assigns a unique Note Serial Number upon the creation of each note; wherein the number serves to identify each note in the system; see Abstract teaches the wherein annotations are posted to the notes server by a notes);

sending association information from the tier II server to a tier I server that is separate and distinct from the tier II and tier III servers (Eintracht on col. 8, lines 34-36 teaches Notes Server functions in conjunction with the Web server 54 (see Figure 3); on col. 6, lines 48-52 teaches web server functions to capture special request from client for creating, storing, editing and retrieving annotations related specific documents from the Notes Server); and

storing the association information on the tier I server (Eintracht on col. 10, lines 19-26 teaches web server receives URLs from client to request annotations from the Notes Server).

However, Eintracht does not explicitly disclose that the Notes Database for storing annotations is a "tier III server".

deVries on col. 7, lines 26-40 see Figure 1A items 30 and 32 teaches an index database server 32 for storing annotations.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified deVries into Eintracht to provide a way to store annotations in an index database server, as taught by deVries, incorporated into the Notes

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Database of Eintracht in order provide an efficient and cost-effective distributed annotating media system.

Regarding dependent claim 11, Eintracht discloses:

wherein the acts are performed in the order listed (Eintracht see Abstract teaches creating, storing, editing, and retrieving process for annotations).

Regarding dependent claim 12, Eintracht discloses:

further comprising notifying the client of a successful post to the tier III server (Eintracht on col. 16, lines 38-43 teaches communication with the Notes client; see Abstract teaches annotations are posted to the notes server by a notes client) and (deVries discloses tier III server on col. 7, lines 26-40 see Figure 1A items 30 and 32 teaches an index database server 32 for storing annotations).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified deVries into Eintracht to provide a way to store annotations in an index database server, as taught by deVries, incorporated into the Notes Database of Eintracht in order provide an efficient and cost-effective distributed annotating media system.

Regarding dependent claim 13, Eintracht discloses:

further comprising notifying the client occurs prior to sending the second portion of the annotation to the tier II server (Eintracht see Abstract teaches annotations are posted to the notes server by a notes client).

Regarding dependent claim 14, Eintracht discloses:

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further comprising notifying the tier III server of a successful post to the tier II server (Eintracht on col. 7, lines 45-47 and col. 10, lines 40-63, see Abstract teaches the Note Server and Note Database communicate with each other (see Figure 3).

Regarding dependent claim 15, Eintracht discloses:

further comprising notifying the tier II server of a successful post to the tier I server (Eintracht on col. 8, lines 34-36 teaches Notes Server functions in conjunction with the Web server 54 (see Figure 3); see Abstract teaches annotations are posted).

Regarding dependent claim 16, Eintracht discloses:

wherein sending the annotation post from the client to the tier III server comprises sending a URL for the tier I server, a URL for the tier II server, a URL for the tier III server, a context document identifier, type specific annotation properties, generic annotation properties, and an annotation body (Eintracht on col. 3, lines 53-55, see Abstract teaches URLs are used for managing and administrating the Notes Server and Notes Database; on col. 10, lines 19-39 teaches the Notes Server receives URLs from the Web Server (see Figure 3)) and (deVries discloses "tier III server" on col. 7, lines 26-40 see Figure 1A items 30 and 32 teaches an index database server 32 for storing annotations).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified deVries into Eintracht to provide a way to store annotations in an index database server, as taught by deVries, incorporated into the Notes Database of Eintracht in order provide an efficient and cost-effective distributed annotating media system.

Regarding dependent claim 17, Eintracht discloses:

wherein storing a portion of the annotation on the tier III server comprises storing the annotation body and the type specific annotation properties (Eintracht on col. 10, lines 40-63 teaches Notes Database 60 records Note Document ID, Note Contents, Note anchor coordinates, Note Time Stamp, and Note Owner ID).

Regarding dependent claim 18, Eintracht discloses:

further comprising generating a unique identifier for the annotation body and type specific annotation properties stored on the tier III server (Eintracht on col. 8, lines 6-23 teaches creating a unique identifier for the note).

Regarding dependent claims 19 and 20, Eintracht discloses:

wherein sending and storing a second portion of the annotation to the tier II server comprises sending a URL or the tier I server, a URL for the tier II server, a URL for the tier III server, a context document identifier, generic annotation properties, and the unique identifier (Eintracht on col. 3, lines 53-55, see Abstract teaches URLs are used for managing and administrating the Notes Server and Notes Database; on col. 10, lines 19-39 teaches the Notes Server receives URLs from the Web Server (see Figure 3)) and (deVries discloses "tier III server" on col. 7, lines 26-40 see Figure 1A items 30 and 32 teaches an index database server 32 for storing annotations).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified deVries into Eintracht to provide a way to store annotations in an index database server, as taught by deVries, incorporated into the Notes Database of Eintracht in order provide an efficient and cost-effective distributed annotating media system.

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Regarding dependent claim 21, Eintracht discloses:

wherein sending association information to the tier I server comprises sending the tier I server URL, the tier II server URL, the context document identifier and an indexing identifier storing the association information on the tier I server (Eintracht on col. 8, lines 34-36 teaches Notes Server functions in conjunction with the Web server 54 (see Figure 3); on col. 6, lines 48-52 teaches web server functions to capture special request from client for creating, storing, editing and retrieving annotations related specific documents from the Notes Server; and col. 10, lines 19-26 teaches the web server transmits URLs to the Notes Server).

Regarding independent claims 22 and 23, Eintracht discloses:

A computer-readable medium having stored thereon a "client-to-tier III server" data structure for scalable annotations comprising:

a first field containing data representing a context document identifier; a second field containing data representing a body of the annotation; a third field containing data representing generic properties of the annotation; a fourth field containing data representing type specific properties of the annotation (Eintracht on col. 16, line 67 – col. 17, line 15, col. 18, lines 18-35, see Figures 10-13 teaches a note data structure comprising a plurality of fields such as Document ID field; the text (content of the note); note anchor; note time stamp...(generic and type specific properties));

a fifth field containing data representing a URL for a tier III server for receiving and storing a portion of the post of the annotation (Eintracht on col. 10, lines 40-63 teaches Notes Database, see Abstract teaches storing and receiving posted annotations; wherein the annotations are stored in the Notes Database);

a sixth field containing data representing a URL for a tier II server for receiving and storing a portion of the post of the annotation wherein the URL for the tier II server is distinct from the URL for the tier III server (Eintracht on col. 3, lines 53-55 teaches URLs are used for managing and administrating the Notes Server and Notes Database; see Abstract the network system for receiving and storing posted annotations); and

a seventh field containing data representing a URL for a tier I server for receiving and storing associations for the annotation, wherein the URL for the tier I server is distinct from the URLs for the tier II and tier III servers (Eintracht on col. 10, lines 19-39 teaches the Notes Server receives URLs from the Web Server; see Figure 3 shows distinct and separate computer systems).

However, Eintracht does not explicitly disclose that the Notes Database for storing annotations is "a tier III server".

deVries on col. 7, lines 26-40 see Figure 1A items 30 and 32 teaches an index database server 32 for storing annotations.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified deVries into Eintracht to provide a way to store annotations in an index database server, as taught by deVries, incorporated into the Notes Database of Eintracht in order provide an efficient and cost-effective distributed annotating media system.

Regarding independent claim 24, Eintracht discloses:

A computer-readable medium having stored thereon a "tier II server-to-tier I" server data structure for scalable annotations comprising:

a first field containing data representing a context document identifier; a second field containing data representing an indexing identifier of the annotation (Eintracht on col. 16, line 67 – col. 17, line 15, col. 18, lines 18-35, see Figures 10-13 teaches a note data structure comprising a plurality of fields such as Document ID field; the text (content of the note); note anchor; note time stamp...(generic and type specific properties));

a third field containing data representing a URL for the tier II server for indexing the annotation (Eintracht on col. 3, lines 53-55 teaches URLs are used for managing and administrating the Notes Server and Notes Database; on col. 8, lines 61-63 teaches Notes Server assigns a unique Note Serial Number upon the creation of each note; wherein the number serves to identify each note in the system; col. 10, lines 27-39, see Figure 3 teaches a Notes Server 58 functions to receive modified URLs from the Note Agent; the Notes Server receives request from the Web Server to retrieve annotations from the Notes Database 30); and

a fourth field containing data representing a URL for a tier I server for receiving and storing associations for the annotation, wherein the URL for the tier I server is distinct from the URL for the tier II server (Eintracht on col. 10, lines 19-39 teaches web server receives URLs from client to request annotations from the Notes Server; the Notes Server receives URLs from the Web Server; see Figure 3 shows distinct and separate computer systems).

However, Eintracht does not explicitly disclose that the Notes Database for storing annotations is a “tier III server”.

deVries on col. 7, lines 26-40 see Figure 1A items 30 and 32 teaches an index database server 32 for storing annotations.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified deVries into Eintracht to provide a way to store annotations in an index database server, as taught by deVries, incorporated into the Notes Database of Eintracht in order provide an efficient and cost-effective distributed annotating media system.

Regarding independent claim 25, Eintracht discloses:

A scalable computerized method for managing annotations, the method comprising:

storing within a tier I server reference to a tier II server for storing an index that identifies a tier III server; storing within a tier II that is separate and distinct from the tier I server an index that identifies the tier III server that stores an annotation associated with a content source (Eintracht on col. 8, lines 61-63 teaches Notes Server assigns a unique Note Serial Number upon the creation of each note; wherein the number serves to identify each note in the system; the Notes Server receives request from the Web Server to retrieve annotations from the Notes Database 30; see Figure 3 shows the Notes Server coupled to the Notes Database used to store annotations; on col. 10, lines 27-39 teaches the Notes Server receives URLs to identified the stored annotations from the Notes Database) that stores an annotation associated with a content source (Eintracht see Abstract teaches storing annotations with related document);

storing within a tier III server that is separate and distinct from the tier I and tier II servers annotation associated with a content source (Eintracht see Abstract teaches storing annotations with related document; see Figure 3 shows Notes database used for storing annotations is coupled to the Notes Server);

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receiving by the tier I server from a client a document identifier that identifies the content source (Eintracht on col. 4, lines 15-18 teaches URL associated with a document is transmitted from client to server; see Figure 3 shows client 42 in communication with the Web Server 54); and

providing a first response to the client from the tier I server, wherein the first response comprises one for more associations for the document identifier and a reference a tier II server for each of the associations (Eintracht on col. 4, lines 13-37 teaches a response from server to client using URL that is associated with the document to be viewed and annotated).

However, Eintracht does not explicitly disclose that the Notes Database for storing annotations is a “tier III server”.

deVries on col. 7, lines 26-40 see Figure 1A items 30 and 32 teaches an index database server 32 for storing annotations.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified deVries into Eintracht to provide a way to store annotations in an index database server, as taught by deVries, incorporated into the Notes Database of Eintracht in order provide an efficient and cost-effective distributed annotating media system.

Regarding dependent claims 26, Eintracht discloses:

further comprising: receiving by the tier II server from the client a selection identifying one of the associations for the document identifier (Eintracht on col. 10, lines 24-26 teaches the Notes Server receives URLs); providing a second response to the client from the tier II server, wherein the second response comprises a header for each of the annotations associated with the

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document identifier and the reference to the tier III server for each annotation (Eintracht on col. 4, lines 13-37 teaches sending a response to the client from the server using a URL).

Regarding dependent claim 27, Eintracht discloses:

further comprising: receiving by the tier III server from the client an annotation identifier (Eintracht on col. 10, lines 40-63 teaches a Note Document ID and Note Owner ID (client ID) are stored in the Notes Database); and providing a third response to the client from the tier III server, wherein the third response comprises a body for the annotation identified by the annotation identifier (Eintracht on col. 4, lines 13-37 teaches response to the client from the server).

Response to Arguments

7. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Almari Yuan whose telephone number is (703) 305-5945. The examiner can normally be reached on Mondays - Fridays (8:30am - 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

AY
February 5, 2004


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER